

### **REMARKS**

The Office Action mailed September 11, 2003 has been carefully considered. Reconsideration of this application in view of the following remarks is respectfully requested.

#### **Attached Exhibit Showing Prior Amendments**

It has come to the attention of the undersigned that the Reply mailed in this application on August 22, 2003 inadvertently used an incorrect amendment format. The amendments to the specification and claims presented in that Reply were shown in final (clean) form without the markup showing the changes made. The undersigned sincerely regrets the unintentional formatting error. Since the Office Action mailed September 11, 2003 makes no objection to the amendment format, it is believed that the amendments presented in the August 22, 2003 Reply were entered irregardless of the incorrect procedure used. The undersigned requests that the Examiner ensure that the amendments to the specification as presented in the August 22, 2003 Reply were made to the specification as presented.

In order to ensure that the written record in this application is complete, a copy of pages 2 – 8 of the August 22, 2003 Reply showing the marked up changes to the specification and claims has been attached as an Exhibit to this Reply. Since the undersigned believes that the amendments shown in the Exhibit have already been entered, no action need be taken with respect to the Exhibit document.

#### **The Claims**

Claims 1 – 13, including independent claims 1, 4, 7 and 13, are pending in this application. Claims 4 and 7 have been amended to correct an antecedent basis problem with respect to the applied force. The Listing of Claims in this Reply reflects the amendments made in the prior Reply and is the current version of all claims pending in this application.

These amendments are made to merely correct inadvertent grammatical errors and are neither in response to nor related to a substantive reason for patentability, nor are they intended to narrow the scope of the claims nor to effect the Doctrine of Equivalents as it might be applied to the claims, were they unamended.

### **Information Disclosure Statements**

The undersigned acknowledges receipt of a copy of the Information Disclosure Statement (IDS) filed with Reply dated August 22, 2003.

Applicants also mailed an IDS on September 2, 2003, prior to the mailing date of the September 11 2003 Office Action, with a single reference document authored by Guenther et al. The undersigned notes that a copy of the Form 1449 with the cited reference has not yet been returned with the Examiner's initials showing that the Examiner has considered and made of record the cited reference. It is respectfully requested that consideration of this document be acknowledged in the next Office Action.

### **35 USC § 102 Rejection**

In the Office Action, Claims 1 - 13 were rejected, in paragraph 4, under 35 U.S.C. § 102 as being anticipated by Abelow (US 5,999,908).

- A. The Office Action fails to state a *prima facie* case of anticipation under 35 U.S.C. § 102: arguments presented in the 8/03 Reply are incorporated by reference in this Reply.

Establishing a *prima facie* case of anticipation under Section 102 requires that a single reference teach (i.e., identically describe) each and every element of the rejected claim. That is, Section 102 anticipation requires that *all* of the elements and limitations of the claim be found within a *single* prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. The elements must be arranged as required by the claim, but identity of terminology is not required. MPEP §2131 (citations omitted). It follows that the Office Action must explicitly show or it must be obvious where each and every

claim element is taught in the reference to meet the burden of establishing the *prima facie* case so that the applicant may have an opportunity to respond.

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. MPEP §2111 (citation omitted). Applicants are aware that broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. However, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. The words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification, and are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning. MPEP §2111.01 (citations omitted).

With reference to independent claims 1, 4 and 7, Abelow does not teach each and every claim limitation of claims 1, 4 and 7 and therefore, as a matter of law, cannot anticipate these claims. Applicants provided extensive comments in the August 22, 2003 Reply (herein after "the 8/03 Reply") arguing that the Office Action did not state a *prima facie* case of anticipation under 35 U.S.C. § 102, primarily because the Office Action failed to recite where in the Abelow reference certain limitations of the independent claims were disclosed or taught and because applicants are unable to ascertain where in the 91 page reference the limitations are disclosed or taught. These arguments are incorporated by reference in this Reply and the Examiner is respectfully requested to review them again, in view of the following additional remarks.

- B. The Office Action does not state a *prima facie* case of anticipation under 35 U.S.C. § 102 because the disclosure recited in the Abelow reference does not teach the invention as recited in all of the claim language of the independent claims.

---

In addition to the arguments presented in the 08/03 Reply, the Office Action does not state a *prima facie* case of anticipation under 35 U.S.C. § 102 because

the alleged invention taught in the Abelow reference does not teach all of the claim limitations of the independent claims. With respect to claims 1, 4 and 7, the Office Action fails to (1) identify multiple actuators; (2) identify a force applied by the actuators; (3) identify any structure upon which the force is applied; (4) recite a passage in Abelow that teaches that an actuator controller is responsive to price information to control an applied force by the actuator on the structure; and (5) recite a passage in Abelow that teaches that price information is conveyed to the actuator controllers by analog fluctuations in an electrical characteristic of the marketwire as recited in applicants claims. Further with respect to claim 4, the Office Action fails to recite a passage in Abelow that (1) identifies a mobile structure, and (2) teaches that an actuator controller is responsive to price information to control an applied force by the actuator to collectively promote movement of a structure from a first position to a second position. Further with respect to claim 7, the Office Action fails to recite a passage in Abelow that teaches that an actuator controller is responsive to price information to control an applied force by the actuator to collectively counter movement of a structure from a first position to a second position.

1. Neither actuators, structure, nor applied force are identified as being taught in Abelow.

The September 11, 2003 Office Action identifies the claim language of "multiple actuators, each of the multiple actuators having an actuator controller that is responsive to price information to control an applied force by the actuator on the structure" from Claim 1 as corresponding to Col. 2, lines 13-27 which states:

*"This Customer-Based Product Design Module invention uses a combination of computer hardware, software and communications technologies to construct module that is built into certain products and services, to establish a network of customer-vendor-distributor interactions and communications (or a network of internal-organization-wide-interactions-in-the area of computer-based performance). These make possible new customer and user roles in the design and development of*

*products and services, and customer-vendor relationships. Over time, this may produce a gradual transfer to customers of commercial direction and market control both in individual cases (such as the evolution of a particular product) and in aggregate, from vendors and distributors."*

However, upon examination of this paragraph it is clear that this language provides a description of a "product or service that contains a microprocessor and a facility for communication" as noted in the Office Action. There are no actuators applying a force to any structure as recited in Applicant's independent claims. Indeed, the entire reference is directed to how such a communication between a product user and a distributor/developer might be provided and utilized. There is nothing that Applicant can ascertain in the 91 pages of Abelow directed towards actuators applying a force to a structure as recited in Applicant's independent claims. Applicants suspects that this reference and paragraph were selected because they happened to merely contain the words "construct" and "market" which were found using a key-word search, and not from any specific understanding of either Applicant's invention or the reference.

The Office Action further identifies the claim element of "an electrical conductor for transmitting voltage and accumulating charge, referred to as a marketwire; the marketwire being connected to each actuator controller to convey price information to the actuator controllers by analog fluctuations in an electrical characteristic of the marketwire" as being taught in "Col. 76, lines 61-65" and "Col. 70 lines 60-11[sic]" These excerpts state:

*"The present invention may provide many types of specialized feedback systems from customers and markets by enabling them to "talk back" to products, so that specific audiences at vendor companies may accomplish their objectives better than is currently possible, such as:..." and*

*"...homes will produce an enormous expansion in the products and services that may be marketed and delivered over networks. In this context, which is the emergence of networked societies and economies, this invention is more than just a reflection of the financial needs of Vendors to increase*

*revenues and profits. It can also be seen as a reflection of the emerging beliefs, assumptions, and values of such a networked society or economic system."*

and describe the economic value of a networked society and more specifically how customers of a product or service might "talk back" to those products and communicate directly with the vendors of those products to provide input for research and development etc. As can clearly be seen, these passages do not describe an electrical conductor conveying information to an actuator by variations in the electrical characteristics in the electrical conductor.

It is respectfully submitted that this disclosure does not teach at least three of the claim limitations of claim 1, as described above: conveying price information to the actuator controllers by analog fluctuations in an electrical characteristic of an electrical conductor; actuator controllers that control the applied force by the actuators on the structure, and an electrical conductor connected to the each actuator controller for conveying the price information. Therefore, the Office Action does not make a *prima facie* case of anticipation under §102 with respect to claim 1. And since no disclosure was recited with respect to promoting movement or countering movement of the structure, as recited in claims 4 and 7, the Office Action does not make a *prima facie* case of anticipation under §102 with respect to claims 4 or 7 as well and Applicant respectfully requests that the rejection must be withdrawn.

2. No prima facie case of anticipation has been presented for any of the dependent claims.

The Office Action does not recite the specific portions of Abelow that teach each and every one of the claim limitations of the dependent claim limitations that might form the basis for allowable subject matter. Indeed, the Office Action does not address any of the dependent claims. For example claim 11, which depends from claim 4, recites air jets as a claim limitation for the multiple actuators and a piece of paper as the structure. The Office Action fails to recite where Abelow teaches the limitation of claim 11; nor does the Office Action make a §103

rejection based on a combination of Abelow and another reference that does teach the recited air jets and paper.

Claim 12, which also depends from claim 4, recites a robotic arm as the structure, and recites the multiple actuator controllers as being responsive to price information to control the applied forces of the multiple actuators to collectively promote movement. The Office Action fails to recite where Abelow teaches this limitation of claim 12, and the Office Action makes no §103 rejection based on a combination of Abelow and another reference that teaches the recited robotic arm. However, one of the two remarks in the Office Action on page 3 states:

*“ ‘a control assembly for controlling structures wherein the structure is physical in nature, e.g., a robotic arm or a beam.’ However, the Examiner respectfully disagrees because the claims (1, 4 and 7) do not recite “a robotic arm or beam” and therefore, the structure can be interpreted as any structure.”*

First, no such argument was made in the 8/03 Reply, and therefore the comment was not responsive to the arguments made in the 8/03 Reply. However, as shown above, claim 12 actually recites a robotic arm. Unfortunately, as the office action does not address any of the additional limitations of the dependent claims, there is no way to know from the Office Action whether claim 4 would be allowable if rewritten to include the limitation of either claim 11 or claim 12. Therefore, the Office Action has failed to provide a *prima facie* case of anticipation for any of the dependent claims and Applicant respectfully requests that the rejection be withdrawn.

For the foregoing reasons it is believed that no *prima facie* case of the anticipation under 35 USC 102(b) of independent claims 1, 4, 7 and 13 has been made, the rejection must be withdrawn, and they are believed to be in condition for allowance. Insofar as claims 2 – 3, 5 – 6, and 8 – 12 are concerned, these claims all include the limitations of, and depend from their respective independent and now presumably allowable claims 1, 4 and 7. For this reason and because the claims contain additional limitations, it is believed that the rejection under 35

Appl. No. 09/404,729  
Amdt. dated December 11, 2003  
Reply to Office action of September 11, 2003

USC 102(b) must be withdrawn and these claims are also in a condition for allowance.

### **Concluding Remarks about the September 11 2003 Office Action**

In the 8/03 Reply in this application, an extensive and detailed showing was presented for each claim element in independent claims 1, 4 and 7 arguing that Abelow does not teach the required combination of elements in each of those claims in the Office Action. The present Office Action fails to respond to any of Applicants arguments or particularly point out where the reference teaches the limitations of the claimed invention. The burden of establishing the prima facie case is on the Examiner, not the Applicants. While the Examiner may interpret the claims broadly for purposes of examination, that broad interpretation may not read out express limitations in applicants' claims.

The undersigned notes that, with the exception of updating the number of claims pending in this application, the September 11, 2003 Office Action is virtually an exact duplicate of all prior Office Actions of record in this application. Thus, Applicants have received no guidance in any of the prosecution history as to what might be allowable subject matter.

It is respectfully submitted that, under the Rules of Practice, the Examiner is required to be specific with respect to the teachings of the cited reference as applied to the elements of each and every claim:

#### **37 CFR § 1.104 Nature of examination.**

##### **(c) Rejection of claims.**

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each



Appl. No. 09/404,729  
Amdt. dated December 11, 2003  
Reply to Office action of September 11, 2003

reference, if not apparent, must be clearly explained and each rejected claim specified.


However, the Office Action fails to do so, it recites a few paragraphs of a long and complex reference to reject all the claims as a whole without specifying how the reference shows every element of every claim.

### **Reconsideration Requested**

The undersigned respectfully submits that, in view of the foregoing amendments and remarks, the rejections of the claims raised in the Office Action dated September 11, 2003 must be withdrawn and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that these claims be allowed, and that this case be passed to issue.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he is hereby authorized to call Applicant's attorney, Nola Mae McBain, at Telephone Number (650) 812-4264, Palo Alto, California.

Respectfully submitted,

  
Nola Mae McBain  
Attorney for Applicant(s)  
Registration No. 35,782  
Telephone: 650-812-4264

Date: December 11, 2003

Exhibit Attachment: Pages 2 – 8 of the August 22 2003 Reply showing the changes made to the specification and claims in marked-up format – for the record only; no action required.